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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,801	10/29/2003	Shenshen Wu	20002.0263D	6064

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SWIDLER BERLIN LLP
3000 K STREET, NW
BOX IP
WASHINGTON, DC 20007

EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,801

Applicant(s)

WU ET AL.

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

The status of the parent applications must be updated at the beginning of the specification.

9-461736 and 9-311591 do not have support for the resilience index claimed.

The effective filing date for the claims is 11/27/00.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 17-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Binette '684 or Nesbitt '594 in view of Moriyama '856.

Binette (table 11) and Nesbitt (table 30) exemplify golf ball cores of CB22, zinc diacrylate and peroxide. Polyurethane covers can be used (Binette col 16 line 8; Nesbitt col 14 line 37). CB22 is one of applicant's preferred rubbers (page 32 of spec). Also, Neocis 40 and Neocis 60 rubbers of these references are believed to correspond to applicant's BR-60 and BR-40. This is surmised from the assignee's use of the phrase "neocis BR40" in US6290611 (col 7 line 21).

Binette and Nesbitt lack the inclusion of organosulfur cis-to-trans catalysts in the core. Moriyama teaches (col 2 line 47-64) inclusion of such organosulfur compounds improve golf ball cores. It would have been obvious to include such compounds for their expected advantages. Note "organophosphorous" is a misprint as the subsequently named species are sulfides.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6486261. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims golf balls with cores of the same rubber and cis-to-trans catalyst. The claims of the patent do not call for a crosslinker, but is well known in the art that crosslinkers (eg zinc acrylate) are normally necessary to cure polybutadiene golf ball cores. The examples of the patent indicate the presence of crosslinker is intended to be embraced by the claims.

Claims 1-21 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6818705. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims golf balls with cores of the same rubber and cis-to-trans catalyst. The claims of the patent do not call for a crosslinker, but is well known in the art that crosslinkers (eg zinc acrylate) are normally necessary to cure

polybutadiene golf ball cores. The examples of the patent indicate the presence of crosslinker is intended to be embraced by the claims.

Claims 1-21 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6818724. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims golf balls with cores of the same rubber and cis-to-trans catalyst. The claims of the patent do not call for a crosslinker, but is well known in the art that crosslinkers (eg zinc acrylate) are normally necessary to cure polybutadiene golf ball cores. The examples of the patent indicate the presence of crosslinker is intended to be embraced by the claims.

Claims 1-21 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10-694754. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims the same ball without requiring any particular resilience index. The copending application is broader than the instant claims. Furthermore, the specification of the copending application indicates a resilience index >40 is intended to be embraced by the claims..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of

copending Application No. 10-694746. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims the same ball requiring a certain loss tangent instead of requiring any particular resilience index. Inherently both properties would be present because both of these properties are a function of the composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10-694800. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims the same ball requiring a certain dynamic stiffness instead of requiring any particular resilience index. Inherently both properties would be present because both of these properties are a function of the composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10-694798. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims the same ball requiring a certain trans gradient instead of requiring any particular

resilience index. Inherently both properties would be present because both of these properties are a function of the composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER
David Buttner

4/8/05

